

REMARKS

Claims 37-72 are pending in the application. Claims 37, 49-57, 59-69 and 71-72 are rejected under 35 U.S.C. § 102(e). Paper No. 23, page 3. Claims 37-45 and 47-48 are rejected under 35 U.S.C. § 103(a). Paper No. 23, page 5. Claims 46, 58 and 70 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph, and to include all the limitations of the base claim and any intervening claims. Paper No. 23, page 7. Applicants have cancelled claims 37, 40-44, 47-49, 52-56, 59-61, 64-68 and 71-72. Applicants have added claims 73-79. Therefore, claims 38-39, 45-46, 50-51, 57-58, 62-63, 69-70 and 73-79 are pending in the application. Applicants respectfully traverse the rejections to the above-cited claims for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw the rejections to these claims.

Applicants note that claims 38-39, 45, 50, 57, 62 and 69 were not amended to overcome prior art but to be written in independent form. Hence, the amendments made to claims 38-39, 45, 50, 57, 62 and 69 were not narrowing in scope and therefore no prosecution history estoppel arises from the amendments to claims 38-39, 45, 50, 57, 62 and 69. *Festo Corp v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-1712 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 38-39, 45, 50, 57, 62 and 69 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

I. REJECTIONS UNDER 35 U.S.C. § 102(e):

The Examiner has rejected claims 37, 49 and 61 under 35 U.S.C. § 102(e) as being anticipated by Capps (U.S. Patent No. 5,666,502). The Examiner has further rejected claims 49-57, 59-69 and 71-72 under 35 U.S.C. § 102(e) as being anticipated by Miller (U.S. Patent No. 5,805,911).

Applicants have cancelled claims 37, 40-44, 47-49, 52-56, 59-61, 64-68 and 71-72 without prejudice or disclaimer and therefore the rejections to those claims are moot.

For a claim to be anticipated under 35 U.S.C. § 102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. § 2131.

Applicants respectfully assert that Miller does not disclose "wherein the control program and the processor cooperate, when the control program is executing on the processor, in exercising the predictive widget to supply a predicted default entry for the defined data field" as recited in claim 50 and similarly in claim 62. The Examiner cites column 9, lines 1-8 of Miller as disclosing the above-cited claim limitation. Paper No. 23, page 4. This language in Miller discloses filling an entry in a form with text after the user has entered one or more characters in that entry. This corresponds to predictive filling; however, this does not correspond to a predicted default. A predicted default refers to filling an entry prior to the user entering any characters in that entry. Thus, Miller does not disclose all of the limitations of claims 50 and 62, and thus Miller does not anticipate claims 50 and 62. M.P.E.P. § 2131.

Applicants further assert that Miller does not disclose "wherein the control program and the processor cooperate, when the control program is executing on the processor, in selecting a data entry from the predictive list based upon a user selected

weighted determination of the recency and frequency of use of listed data entries" as recited in claim 57 and similarly in claim 69. The Examiner cites column 8, line 56 – column 9, line 8; column 10, lines 33-43; column 11, lines 1-7 and column 12, lines 3-38 of Miller as disclosing the above-cited claim limitation. Paper No. 23, page 4. This language in Miller discloses a prediction system that includes a plurality of prediction modules. Each prediction module may be configured to generate one or more predictions where each prediction generated is associated with a belief factor. The belief factor is an estimate or likelihood that the associated prediction is correct. This language in Miller further discloses that the prediction module manager selects a prediction from all the predictions provided by the prediction modules based on the belief factor. Miller further discloses that the belief factors generated by these prediction modules may be reweighted based on whether or not the accepted prediction was correct.

However, this language does not disclose selecting a data entry from a list based on a weighted determination of the recency and frequency of use of the listed data entries. Further, Miller discloses a module that specifically uses frequency and another module that specifically uses recency. However, Miller does not disclose a module that uses a combination of both frequency and recency. Further, Miller does not disclose a module that uses a user selected weighted determination of the recency and frequency of use of the listed data entries. As a result of the foregoing, Applicants assert that Miller does not disclose all of the limitations of claims 57 and 69, and thus Miller does not anticipate claims 57 and 69. M.P.E.P. § 2131.

Applicants also respectfully assert that Miller does not disclose "circuitry operable for predicting a default user's choice in an entry in said form" as recited in claim 73. As stated above, Miller discloses predicting the data that the user will enter in an entry after the user has entered one or more characters in that entry. However, this is not the same as predicting data to be entered in an entry by default prior to the

user entering any information in that entry. Thus, Miller does not disclose all of the limitations of claim 73, and thus Miller does not anticipate claim 73. M.P.E.P. § 2131.

Claims 51, 63 and 74-79 each recite combinations of features including the above combinations, and thus are not anticipated for at least the above stated reasons. Claims 51, 63 and 74-79 recite additional features, which, in combination with the features of the claims upon which they depend, are not anticipated by Miller.

For example, Miller does not disclose "wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a predicted default entry from the predictive list based on a predetermined algorithm" as recited in claim 51 and similarly in claim 63. The Examiner cites column 9, lines 25-44, column 9, lines 1-8 and column 12, lines 53-57 of Miller as disclosing the above-cited claim limitation. Paper No. 23, page 4. Applicants disagree. Instead, as stated above, Miller discloses predicting what the user will enter in an entry in a form based on one or more characters entered by the user in that entry. This is not the same as selecting a predictive default entry from a predictive list. As stated above, a predicted default entry may refer to predicting the data that the user will enter in an entry in the form prior to the user entering any information in that entry. Thus, Miller does not disclose all of the limitations of claims 51 and 63, and thus Miller does not anticipate claims 51 and 63. M.P.E.P. § 2131.

Further, Miller does not disclose "wherein said predicting said default user's choice is based on one of a recency and a frequency of data entries previously entered by said user in one or more entries in said form" as recited in claim 74. For at least the reasons stated above, Miller does not disclose all of the limitations of claim 74, and thus Miller does not anticipate claim 74. M.P.E.P. § 2131.

Further, Miller does not disclose "wherein said predicting said default user's choice is based on a combination of a recency and a frequency of data entries previously entered by said user one or more entries in said form" as recited in claim 75. Instead, as stated above, Miller discloses one prediction module that uses frequency and another prediction module that uses recency to predict data entries. This is not the same as a prediction module that uses a combination of recency and frequency. Thus, Miller does not disclose all the limitations of claim 75, and thus Miller does not anticipate claim 75. M.P.E.P. § 2131.

Further, Miller does not disclose "wherein said predictively filling said entry in said form after said user enters one or more characters in said entry is based on a combination of a recency and a frequency of data entries previously entered by said user in one or more entries in said form" as recited in claim 76. Instead, as stated above, Miller discloses one prediction module that uses frequency and another prediction module that uses recency to predict data entries. This is not the same as a prediction module that uses a combination of recency and frequency. Thus, Miller does not disclose all of the limitations of claim 76, and thus Miller does not anticipate claim 76. M.P.E.P. § 2131.

Further, Miller does not disclose "circuitry operable for presenting to said user a list of data entries most likely to be selected by said user to fill an entry in said form, wherein said list of data entries comprises data entries previously entered by said user in one or more entries in said form" as recited in claim 77. Instead, as stated above, Miller does not disclose presenting a list of data entries to the user. Hence, Miller does not disclose all the limitations of claim 77, and thus Miller does not anticipate claim 77. M.P.E.P. § 2131.

Further, Miller does not disclose "wherein said list of data entries is organized by a combination of a recency and a frequency of data entries previously entered by said user in one or more entries in said form" as recited in claim 79. Instead, as stated

above, Miller does not disclose a prediction module that generates a prediction based on the combination of a recency and a frequency of data entries previously entered by a user. This is not the same as a list organized by a combination of a recency and a frequency of data entries previously entered by the user. Thus, Miller does not disclose all of the limitations of claim 79, and thus Miller does not anticipate claim 79.

As a result of the foregoing, Applicants respectfully assert that not each and every claim limitation was found within the cited prior art reference and thus claims 50-51, 57, 62-63, 69 and 73-79 are not anticipated by Miller.

II. REJECTIONS UNDER 35 U.S.C. § 103(a):

The Examiner has rejected claims 37-45 and 47-48 under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Capps. Paper No. 23, page 5. Applicants respectfully traverse these rejections for at least the reasons provided below and respectfully request the Examiner to reconsider and withdraw these rejections.

Applicants have cancelled claims 37, 40-44 and 47-48. Therefore, the rejections to these claims are moot.

Applicants respectfully assert that Miller and Capps, taken singly or in combination, do not teach or suggest "wherein the control program and the processor cooperate, when the control program is executing on the processor, in exercising the predictive widget to supply a predicted default entry for the defined data field" as recited in claim 38. The Examiner cites column 9, lines 1-8 of Miller as teaching the above-cited claim limitation. Paper No. 23, page 6. Applicants disagree and assert that Miller instead teaches filling an entry in a form with text after the user has entered one or more characters in that entry. This corresponds to predictive filling; however, this does not correspond to a predictive default. A predictive default refers

to filling an entry prior to the user entering any characters in that entry. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Miller and Capps, taken singly or in combination, do not teach or suggest "wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a predicted default entry from the predictive list based on a predetermined algorithm" as recited in claim 39. The Examiner cites column 9, lines 25-44, column 9, lines 1-8 and column 12, lines 53-57 of Miller as teaching the above-cited claim limitation. Paper No. 23, page 6. Applicants traverse and assert that Miller teaches instead predicting what the user will enter in an entry in a form based on one or more characters entered by the user in that entry. This is not the same as selecting a predictive default entry from a predictive list. As stated above, a predicted default entry may refer to predicting the data that the user will enter in an entry in the form prior to the user entering any information in that entry. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998).

Applicants also respectfully assert that Miller and Capps, taken singly or in combination, do not teach or suggest "wherein the control program and the processor cooperate, when the control program is executing on the processor, in selecting a data entry from the predictive list based upon a user selected weighted determination of the recency and frequency of use of listed data entries" as recited in claim 45. The Examiner cites column 8, line 56 – column 9, line 8; column 10, lines 33-43; column 11, lines 1-7 and column 12, lines 3-38 of Miller as teaching the above-cited claim limitation. Paper No. 23, page 6. Applicants traverse and assert that Miller

teaches a prediction system that includes a plurality of prediction modules. Each prediction module may be configured to generate one or more predictions where each prediction generated is associated with a belief factor. The belief factor is an estimate or likelihood that the associated prediction is correct. Miller further teaches that the prediction module manager selects a prediction from all the predictions provided by the prediction modules based on the belief factor. Miller further teaches that the belief factors generated by these prediction modules may be reweighted based on whether or not the accepted prediction was correct. This is not the same as selecting a data entry from a list based on a weighted determination of the recency and frequency of use of the listed data entries. Miller teaches a module that specifically uses frequency and another module that specifically uses recency. However, Miller does not teach a module that uses a combination of both frequency and recency. Further, Miller does not teach a module that uses a user selected weighted determination of the recency and frequency of use of the listed data entries. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998).

Further, Miller and Capps, taken singly or in combination, do not teach or suggest "circuitry operable for predicting a default user's choice in an entry in said form" as recited in claim 73. As stated above, Miller teaches predicting the data that the user will enter in an entry after the user has entered one or more characters in that entry. However, this is not the same as predicting data to be entered in an entry by default prior to the user entering any information in that entry. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998).

Claims 74-79 recite combinations of features including the above combinations, and thus are patentable for at least the above reasons as well. Claims 74-79 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Miller in view of Capps.

For example, Miller and Capps, taken singly or in combination, do not teach or suggest "wherein said predicting said default user's choice is based on one of a recency and a frequency of data entries previously entered by said user in one or more entries in said form" as recited in claim 74. For at least the reasons stated above, the Examiner has not presented a *prima facie* case of obviousness. M.P.E.P. § 2143.

Further, Miller and Capps, taken singly or in combination, do not teach or suggest "wherein said predicting said default user's choice is based on a combination of a recency and a frequency of data entries previously entered by said user one or more entries in said form" as recited in claim 75. Applicants traverse and assert that Miller instead teaches one prediction module that uses frequency and another prediction module that uses recency to predict data entries. This is not the same as a prediction module that uses a combination of recency and frequency. Further, the Examiner has not provided any evidence that Capps or Miller, in combination with Capps, teach or suggest the above-cited claim limitation. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998).

Further, Miller and Capps, taken singly or in combination, do not teach or suggest "wherein said predictively filling said entry in said form after said user enters one or more characters in said entry is based on a combination of a recency and a frequency of data entries previously entered by said user in one or more entries in said form" as recited in claim 76. Instead, as stated above, Miller teaches one prediction module that uses frequency and another prediction module that uses

recency to predict data entries. However, this is not the same as a prediction module that uses a combination of recency and frequency. Further, the Examiner has not provided any evidence that Capps or Miller, in combination with Capps, teach or suggest the above-cited claim limitation. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998).

Further, Miller and Capps, taken singly or in combination, do not teach or suggest "circuitry operable for presenting to said user a list of data entries most likely to be selected by said user to fill an entry in said form, wherein said list of data entries comprises data entries previously entered by said user in one or more entries in said form" as recited in claim 77. Instead, as stated above, Miller does not teach presenting a list of data entries to the user. Further, the Examiner has not provided any evidence that Capps or Miller, in combination with Capps, teach or suggest the above-cited claim limitation. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998).

Further, Miller and Capps, taken singly or in combination, do not teach or suggest "wherein said list of data entries is organized by a combination of a recency and a frequency of data entries previously entered by said user in one or more entries in said form" as recited in claim 79. Instead, as stated above, Miller does not teach a prediction module that generates a prediction based on the combination of a recency and a frequency of data entries previously entered by a user. This is not the same as a list organized by a combination of a recency and a frequency of data entries previously entered by the user. Further, the Examiner has not provided any evidence that Capps or Miller, in combination with Capps, teach or suggest the above-cited

claim limitation. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998).

As a result of the forgoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art. Thus, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 38-39, 45 and 73-79 in view of the cited prior art. M.P.E.P. § 2143.

III. ALLOWABLE SUBJECT MATTER:

Claims 46, 58 and 70 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph, set forth in this Office Action and to include all the limitations of the base claim and any intervening claims. Paper No. 23, page 7. Applicants respectfully note that the Examiner did not reject claims 46, 58 and 70 under 35 U.S.C. § 112 in this Office Action. Applicants assume that the Examiner mistakenly thought that the Examiner rejected claims 46, 58 and 70 under 35 U.S.C. § 112. Applicants further note that claims 46, 58 and 70 were already amended to be written in independent form and therefore include all the limitations of the base claim and any intervening claims. Therefore, claims 46, 58 and 70 are allowable.

IV. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 38-39, 45-46, 50-51, 57-58, 62-63, 69-70 and 73-79 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Applicants

By: 

Robert A. Voigt, Jr.
Reg. No. 47,159
Kelly K. Kordzik
Reg. No. 36,571

P.O. Box 50784
1201 Main Street
Dallas, Texas 75250-0784
(512)370-2832

AUSTIN_1\233445\2
7036-P151US